

### **REMARKS**

In the Office Action, claims 1-21 are pending. Claim 21 has been withdrawn from consideration, and is canceled herein without prejudice or disclaimer. In the Office Action, the previous amendment to claim 1 is objected to as introducing new matter to the specification; claims 1-20 stand rejected under 35 U.S.C. §101 as being directed towards non-statutory subject matter; claims 1-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite; and claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over an article entitled “Big Name Investors Sign up to Back Constellar’s Hub” (“Article”) and Young et al. (U.S. Patent No. 6,915,270). Applicants respectfully traverse these rejections.

#### **Claim Objection – Alleged New Matter**

The Office Action indicates the examiner scanned the specification, and did not find discussion of presenting an initial customer interface and gathering feedback recited in claim 1. Applicants submit that support for this claim may be found, among other places, at paragraphs [0066] (e.g., “web-based screen demonstrations”), [0068] (e.g., “... gathering customer feedback and suggestions ...”) of the specification, and [0077] (e.g., in the second stage, “... confirming and/or refining the targeted customer experience and relationship ...”). Reconsideration and withdrawal of this objection is respectfully requested.

#### **Claim Objections – Improper Dependent Form**

The Office Action objects to claims 2-20 under 37 CFR 1.75(c) as being improper dependent form for failing to further limit the subject matter of a previous claim. In particular,

the Office Action bases this rejection on the fact that the dependent claims do not recite the customer interface or feedback features found in claim 1.

Applicants submit that this objection is improper, and should be withdrawn. Dependent claims 2-20 further limit claim 1 by reciting additional features that are not expressly required by claim 1. That is all that is required for a proper dependent claim under 37 CFR 1.75.

### **Claim Rejections - 35 U.S.C. § 101**

In alleging that claims 1-20 fail to recite statutory subject matter, the Office Action contends that there is a two-prong test in 35 U.S.C. §101, where the invention has to be 1) within the “technological arts” and 2) must produce a useful, concrete and tangible result. The Office Action concedes that Applicants’ claims satisfy the second prong, and recite inventions that produce useful, concrete and tangible results, but alleges that the claims fail the first prong because the claims do not “apply, involve, use, or advance the technological arts.”

There is no legal basis, statutory or otherwise, for this first prong, and there is no legal basis for making a separate “technological arts” rejection, distinct from a utility rejection, under 35 U.S.C. §101. The relevant inquiry is as stated in section 101: the invention must be new and useful.

The Office Action relies on In re Toma, 197 USPQ 852 (CCPA 1978) for establishing a separate “technological arts” requirement. The Toma decision does not establish such a requirement. To the contrary, the Toma court rejected that examiner’s suggestion that such a separate requirement even existed. In Toma, the examiner rejected the claims to a computerized method of translating, alleging that it was not statutory subject matter because it was not within the “technological arts.” Id., at 857 (“The examiner, in his Final Rejection and

in his Examiner's Answer, appears to have rejected the claims because a computerized method of translating is not, the examiner submitted, in the 'technological arts.' The examiner cited *In re Musgrave*, 57 CCPA 1352, 431 F.2d 882, 167 USPQ 280 (1970); *In re Benson*, 58 CCPA 1134, 441 F.2d 682, 169 USPQ 548 (1971), rev'd sub nom. *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972); *In re McIlroy*, 58 CCPA 1249, 442 F.2d 1397, 170 USPQ 31 (1971), for the proposition that all statutory subject matter must be in the "technological" or "useful" arts ..."). The Court of Customs and Patent Appeals (CCPA) rejected the examiner's suggestion that such a separate requirement existed in the patent laws:

The language which the examiner has quoted was written in answer to "mental steps" rejections and was not intended to create a generalized definition of statutory subject matter. Moreover, it was not intended to form a basis for a new §101 rejection as the examiner apparently suggests. To the extent that this "technological arts" rejection is before us, independent of the rejection based on *Benson*, it is also reversed.

The relevant inquiry is, as stated in 35 U.S.C. §101, on usefulness. Inventions can be patentable so long as they are useful, even if they are not in the "technological arts," and there are many patents out there today that cover useful inventions that one might not consider to be in a "technological art." See, e.g., U.S. Patent Nos. 6,932,343 (method of playing a card game); 6,004,596 (sealed crustless sandwich); and 5,780,082 (process for making pizza). There are, of course, some exceptions in the case law (e.g., mental steps, algorithms and abstract ideas, laws of nature), but none of those are applied in the Office Action.

The Office Action concedes that Applicants' claims recite useful inventions, and that is all that is required under 35 U.S.C. §101 and Toma. The Office Action also cites Ex Parte Bowman, 61 USPQ2d 1669 (BPAI 2001), but that case does not support the separate "technological arts" rejection, either. Instead, the Bowman decision focused on the "mental

steps” doctrine, and did not establish a separate “technological arts” requirement. Furthermore, since that decision is unpublished, it is not even binding precedent on the Board, and is of nearly no value here. For at least the reasons above, Applicants submit that the present claims are directed towards statutory subject matter.

**Claim Rejections – 35 U.S.C. § 112, second paragraph**

Claims 1-20 also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action objects to claim 1, since the claim does not limit precisely how the recited steps take place. Applicants agree that the claims do not place express limitations on how the recited steps are to be performed, and that the claim scope is broad enough to encompass a variety of ways in which the steps may be performed. This breadth, however, does not render the claim indefinite. See, e.g., MPEP §2173.04 (“Breadth is Not Indefiniteness”). Applicants submit that the language in the claims is clear, and that those of ordinary skill in the art will have no trouble discerning the claims’ scope.

**Claim Rejections – 35 U.S.C. §103(a)**

The Office Action rejects independent claim 1 as being obvious in view of an alleged combination of the Article with Young et al. However, in making this rejection, the Office Action appears to be referring to different claim language from what is recited. In particular, the Office Action refers to a step of “overhauling the marketing of the product in the world.” Office Action, p. 10. No such language is recited in claim 1, or in any other claim. The Office Action relies on Young et al. to show this “overhauling” feature, although claim 1 does not recite such a feature.

Additionally, the Office Action appears to ignore other language that is recited in the claims. Specifically, claim 1 recites “said first stage approach including the steps of presenting an initial customer interface and gathering customer feedback” and “said second stage approach including the step of refining said customer interface based on said customer feedback.” The Office Action does not address these features, and upon a review of the cited Article and Young et al., Applicants do not see any such method with such features. Applicants request clarification as to where such a method is allegedly taught in the cited references, so that the matter may be clear on appeal.

Furthermore, the Office Action provides no motivation or suggestion for combining the two cited references. The Article is barely one page long, and reports the costs and financing efforts of a company named “Constellar.” According to the Article, Constellar expected revenues in 1998 to be between \$18M and \$19M, and delayed its initial public offering from 1998 to 1999 or 2000 due to poor marketing. Young et al. relates to a specific customer relationship management business method. Young et al. makes no reference to the Article or Constellar, and the Article makes no reference to Young et al. The two references appear to have nothing to do with one another, and the alleged combination is improper without a citation, from the prior art, of a motivation or reason that would have led one of ordinary skill to combine the Young et al. system with the Constellar Article. Again, to clarify the issues for appeal, Applicants request clarification as to the reason why the Office Action contends one of ordinary skill would have been motivated to combine the Constellar Article and Young et al.

Claims 2-20 depend from claim 1, and are allowable for at least the same reasons as claim 1, and further in view of the various features recited therein. The Office Action rejects each of these nineteen claims as being either taught by Young et al. Figs. 1-7 and Tables 1-5, or

that the “adjusting of these variables are within the skilled artisan as routine experimentation.” Applicants submit that this rejection is improper. The blanket citation to Young et al. offers no guidance or clarification as to the actual basis for the rejection, while the allegation about adjusting variables is conclusory and without support.

As examples, with regard to Young et al., the dependent claims recite features not shown in this reference. For example, claim 2 recites the steps of “a) reviewing a business strategy; b) defining an operating vision; c) developing a first stage operating strategy; d) developing at least one first stage priority; e) developing at least one first stage architecture for implementing the first stage strategy to achieve the first stage priority; f) developing a plan for launching the business using the first stage architecture; and g) launching the business. The Office Action cites nothing from Young et al. for these eight steps, and Applicants submit that Young et al. does not teach or suggest these steps. Claims 3, 10 and 16 recite an “architecture is at least one of a business architecture and a component architecture.” Young et al. fails to teach or suggest either such architectures. Claims 4, 11 and 17 recite “the component architecture is at least one of a process architecture, a technical architecture and an organization architecture,” and Young et al. fails to teach or suggest such a component architecture. Claims 8, 14 and 20 recite specific time frames, and Young et al. fails to teach or suggest such time frames. Claims 9 and 15 recite additional steps for the second stage approach, which includes a second stage architecture. The Office Action cites nothing to show this second stage architecture, and Young et al. fails to teach or suggest such a method.

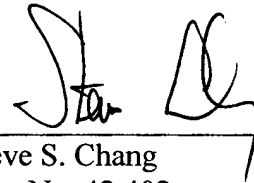
## Conclusion

Applicants respectfully submit that all of the rejections and objections identified in the Office Action should be reconsidered and withdrawn. At a minimum, many of these issues require clarification so that the issues on appeal may be properly addressed. If the examiner feels that additional discussion and/or amendment may be needed to place the application in condition for allowance, the examiner is invited to telephone Applicants' undersigned representative.

Date: \_\_\_\_\_

9/30/2005

Respectfully submitted,



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